



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,523	04/06/2000	MIKEL A. LEHRMAN	ML-1	7812
7590 05/13/2008				
ROBERT W MORRIS FISH & NEAVE 1251 AVENUE OF THE AMERICAS NEW YORK, NY 10020-1104				
EXAMINER				
TRAN, NHAN T				
ART UNIT		PAPER NUMBER		
2622				
MAIL DATE		DELIVERY MODE		
05/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/544,523

**Applicant(s)**

LEHRMAN, MIKEL A.

**Examiner**

NHAN T. TRAN

**Art Unit**

2622

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11, 13, 14, 17-27 and 30-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-32 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13, 14, 17-27 and 33-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-9, 11, 13-14, 17-27, 33-45 have been considered but are moot in view of the new ground(s) of rejection.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 3/5/2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

3. Claim 32 is objected to because of the recitation of "for display on the electronic display." This should be corrected to read as -- for displaying on the electronic display. --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebby et al. (EP 0 798 650) in view of Etoh (US 5,729,289).

Regarding claim 1, Lebby discloses a portable electronic photo album (Figs. 1-13 and col. 4, lines 8-11; col. 1, lines 41-46 and col. 2, lines 16-34, wherein the device acts as an electronic photo album by inherency since it is fully capable of storing and displaying images/video) comprising:

a housing structure (Fig. 1) that fits within a pocket-sized wallet (col. 3, line 56 – col. 5, line 24 and note that the device fits within a pocket-sized wallet since it is also a wallet itself), wherein integrated into the housing structure are:

an electronic display (18) capable of displaying user-provided digital images (Fig. 1 and col. 6, lines 5-54 in which the user-provided digital images are downloaded from a personal computer connected to the device via input/output ports 21);

a memory (i.e., an inherent internal memory *or* a memory card such as compact disc drive, SMART CARD, etc. at slot 26 in Figs. 1 & 2) that stores the user-provided digital images (col. 6, lines 10-30 and col. 8, lines 52-59);

processing circuitry (MPU 50 in Fig. 5) that is operable to display on the electronic display the user-provided digital images stored in the memory, wherein the processing circuitry is coupled to the memory and the electronic display (see Fig. 5 and col. 8, line 35 – col. 9, line 26);

a speaker (audio input/output 62 in Fig. 5 and col. 9, lines 40-42) that emits sound;

a connector component (input/output ports 21 in Fig. 1 and other I/O interface 55 and 56 in Fig. 5) that coupled the photo album to a user device (i.e., a personal computer or PDA, etc., see col. 6, lines 4-9 and col. 8, line 52 – col. 9, line 14), wherein: the user-provided digital images are downloaded from the user device (i.e., the personal computer).

Although Lebby is silent as to “the user device includes a second display component that is separate from the electronic display of the portable electronic photo album”, such a second display is suggested by virtue of “a personal computer” in col. 6, lines 4-9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a second display as a computer monitor that is separate from the display of the portable electronic photo album so as to provide a better view of an image on the computer monitor.

Lebby teaches that the electronic display (18) can be a LCD, OLED, plasma, etc., but Lebby does not explicitly teach that the electronic display is a touch-screen electronic display.

However, as taught by Etoh, it is well known in the art to provide a touch panel (103 in Fig. 1) in front of LCD to enable a touch screen display to enhance the operability of the device (see Etoh, col. 5, lines 13-20). Therefore, it would have been obvious to one of ordinary skill in the art to improve the display unit in Lebby by incorporating a touch panel in front of the display to enable a touch screen display to enhance the operability of the device in a user-friendly fashion.

Regarding claim 4, Lebby in view of Etoh also discloses that the housing includes at least one user interface (input interface shown in Fig. 5 of Lebby or 7a'-7e' in Fig. 4 of Etoh) for advancing which user-provided digital image is displayed on the electronic display.

Regarding claim 5, it is also seen in the combined teaching of Lebby and Etoh that the electronic display also displays at least one user input location for advancing which user-provided digital image is displayed on the electronic display (see Fig. 4 of Etoh).

Regarding claim 6, Lebby clearly discloses that the electronic display is a LCD (col. 6, lines 40-43).

Regarding claim 7, Lebby also discloses that the LCD is substantially flexible (col. 7, lines 45-50).

Regarding claim 8, it is also clearly seen in Fig. 1 of Lebby that the connector component (21) is a physical connector mounted to the housing structure and wherein the user-provided digital images are downloaded via cable connected to the physical connector (refer to claim 1).

Regarding claim 9, Lebby further discloses that the connector component comprises an infrared I/O port, and wherein the user-provided digital images are downloaded via the infrared I/O port (see Lebby, col. 4, lines 37-38).

6. Claims 11, 13, 14, 17-19, 22, 25, 27, 33-42, 44 & 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebby et al. (EP 0 798 650).

Regarding claim 11, this claim is also met by the analysis of claim 1 (without incorporating Etoh). Furthermore, it is inherent in Lebby that the personal computer receives one or more digital images as result of a first user input (keyboard, mouse or CD/memory input) and sends the one or more digital images to the portable electronic photo album as a result of a second user input (keyboard, mouse input) for storage in the memory, wherein said one or more digital images are operable to be displayed on the second display.

Regarding claim 13, Lebby is just silent as to a digital still camera that captures the one or more digital images (see Etoh for a digital still camera shown in Fig. 2A). An Official Notice is taken that it is notoriously well known in the art to connect a digital camera to a personal computer, wherein the digital camera is used to capture one or more digital images and transfers the images into the computer. Therefore, it would have been obvious to one of ordinary skill in the art to provide a digital still camera for capturing one or more digital images and

Art Unit: 2622

then transferring these images into a computer for further processing in a conventional fashion.

Regarding claim 14, it is also seen from claim 13 that the digital camera is also a scanner by virtue of its vertical and horizontal scanning circuit of image sensor.

Regarding claim 17, Lebby teaches a personal computer connected to the portable photo album as discussed above but does not fairly disclose that the computer includes application software for manipulating one or more digital images. However, an Official Notice is taken that it is old and well known in the art to install imaging application software in the personal computer for manipulating digital images so that the user would be able to adjust or edit the images as desired. Therefore, it would have been obvious to one of ordinary skill in the art to install application software in the personal computer in Lebby so as to allow the user to adjust or edit the digital images as desired.

Regarding claim 18, as discussed in claims 1 and 17, since the computer has a second display and application software for editing the image, the edited image is then transferred to the portable photo album for storing and displaying on the display of the photo album. The same edited image is displayed on both the computer display and the photo album display.



Regarding claim 19, this claim is also met by the analysis of claim 1 (without incorporating Etoh). Furthermore, Lebby discloses an electronic flexible display (col. 7, lines 45-50).

Regarding claim 22, this claim is also met by the analyses of claim 1 (without incorporating Etoh).

Regarding claim 25, Lebby also discloses that downloading is accomplished by transferring the one or more user-provided digital images via a conventional interface cable (a cable that connects the personal computer to I/O port 21 in Fig. 1 or a network cable connected at port 55 in Fig. 5).

Regarding claim 27, it's also seen in Lebby that downloading is accomplished by transferring the one or more user-provided digital images via an infrared I/O port (col. 4, lines 37-39).

Regarding claim 33, this claim is also met by the analyses of claims 1 & 11.

Regarding claim 34, please refer to claim 1 (without incorporating Etoh).

Regarding claim 35, it is also seen in Lebby that video clips are stored in said memory and are playable by said processing circuitry to be displayed to the electronic display (col. 1, line 43-44).

Regarding claim 36, this claim is also met by the analysis of claim 1 (without incorporating Etoh).

Regarding claim 37, as seen in Figs. 1-4 of Lebby, the housing structure is hard.

Regarding claim 38, please refer to claim 35.

Regarding claim 39, this claim is also met by the analysis of claim 1 (without incorporating Etoh).

Regarding claim 40, Lebby also shows that the connector component comprises a physical connector that is metallic (conventional I/O port 21 in Fig. 1 is inherently made of metal for electrical conduction), and the user-provided digital images are downloaded via a cable (inherent cable) connected to the electrical connector (col. 6, lines 4-9).

Regarding claim 41, it is also seen in Lebby that the connector component is a wireless port; and the user-provided digital images are downloaded wirelessly via the wireless port (col. 4, lines 37-39 and col. 9, lines 1-3).

Regarding claim 42, Lebby discloses that the wireless port comprises an infrared I/O port (col. 4, lines 37-39).

Regarding claims 44 & 45, as disclosed in col. 9, lines 40-45 and col. 1, line 43, the storage component stores video and audio clips that are played back on the display and speaker.

7. Claims 2 & 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebby and Etoh as applied to claim 1 and in further view of Rowland (US 5,801,970).

Regarding claims 2 & 3, Lebby in view of Etoh teaches the apparatus of claims 1 having a CPU/MPU as a processing circuitry as analyzed above. Lebby and Etoh do not explicitly disclose the processing unit being an ASIC or PLD circuitry. However, as taught by Rowland, it is well known that a processing circuitry can be implemented by either a CPU, ASIC or PLD circuitry (see Rowland, col. 4, lines 49-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an alternative and equivalent circuitry

Art Unit: 2622

such as an ASIC or PLD in place of the CPU/MPU for low cost and possibly low power consumption.

8. Claims 20, 21, 23 & 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebby in view of Rowland (US 5,801,970).

Regarding claims 20, 21, 23 & 24, these claims are also met by the analyses of claims 2 & 3 (without incorporating Etoh).

9. Claims 26 & 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebby in view of Hornback (WO 99/56463).

Regarding claim 26, Lebby does not explicitly disclose that the conventional interface cable is an interface cable that also may be connected to a digital camera.

However, Hornback teaches an interface cable that may be USB or FireWire cable which is known as a highly compatible universal communication cable for allowing the user to connect to a plurality of devices including digital camera, electronic photo album and a computer (Rowland, page 7, lines 19-24).

Therefore, it would have been obvious to one of ordinary skill in the art to configure the system to use USB cable for connecting to all devices because the USB interface is universal series bus that is widely used and highly compatible to almost all electronic devices with the advantage of plug-and-play.

Regarding claim 43, Lebby is silent as to the storage component further includes a removable Flash storage card. However, it is well known in the art that Flash memory is widely used for storing data as an alternative to other storage elements as suggested by Hornback, page 7, liens 13-16. Therefore, it would have been obvious to one of ordinary skill in the art to provide a removable Flash memory card for storing image data because of its compactness and without moving mechanical parts in comparison to a floppy disk or disc drive.

***Allowable Subject Matter***

10. Claims 30-32 are allowed.

11. The following is an examiner's statement of reasons for allowance:

Regarding claim 30, the prior art of record fails to teach or fairly suggest the combination of all limitations of claim 30 that includes the integrated structure of pocket-sized electronic photo album having a magnetic strip that includes credit card information, wherein the magnetic strip is operable to be swiped through a credit card reader, and processing circuitry that is operable to display on the electronic display one or more user-provided digital images, wherein the processing circuitry is coupled to the memory and the electronic display, and a connector that couples the photo album to a user device, wherein the user device includes a second display component that is separate from the electronic display of the portable electronic photo album, and the user-provided digital images are downloaded from the user device.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NHAN T. TRAN whose telephone number is

Art Unit: 2622

(571)272-7371. The examiner can normally be reached on Monday - Friday, 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nhan T. Tran/  
Primary Examiner, Art Unit 2622

